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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,542	02/09/2004	Lau Man Yiu	60036.0008US01	8963
23552	7590	12/19/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			HOGE, GARY CHAPMAN	
			ART UNIT	PAPER NUMBER
			3611	
DATE MAILED: 12/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/774,542	Applicant(s) YIU, LAU MAN	
	Examiner Gary C. Hoge	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-19 is/are pending in the application.
 4a) Of the above claim(s) 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claim 19 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The original claims were directed to the embodiment in which the power source was located within the recessed area. The embodiment in which the power source is located outside the recessed area is a patentably distinct embodiment.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 19 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: “50” (page 3, line 14). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 5, 9, 11, 12 and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by DeWitt (6,776,505).

DeWitt discloses an illuminated display apparatus **10** comprising: a frame member **12** having an exterior side, an interior side, an inner perimeter, and a center opening defined by the inner perimeter; a housing **22** mounted to the frame member and extending outward from the interior side of the frame member, the housing including: a rear wall (Fig. 5), the rear wall having an edge extending around the perimeter of the rear wall; a side member (Fig. 5) having opposing ends, the first end mounted to the edge of the rear wall and the second end disposed adjacent the interior side of the frame member; and a recessed area (Fig. 5) defined by the rear wall and the side member, wherein the recessed area has a depth sufficient for containing a three-dimensional object; a light source **42** mounted within the recessed area, the light source would illumine a three-dimensional object contained within the recessed area of the housing, if it contained one; a transparent plate (Fig. 5) located within the center opening of the frame member, the transparent plate spaced apart from the rear wall of the housing, wherein the interior side of the frame member further comprises a notch portion (Fig. 5) for retaining the transparent

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plate, the notch portion extending along the inner perimeter of the frame member; and a power source **18** conductively connected to the light source for illuminating the light source.

Regarding claim 2, the bottom of housing **22** constitutes a means for supporting a three-dimensional object.

Regarding claim 5, the plurality of flanges shown in Figs. 5 and 6 constitute a plurality of bracket members attached to the side member.

Regarding claims 15 and 17, see Fig. 6 and note battery **50**.

Regarding claims 16 and 18, see Figs. 1 and 2.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5, 6, 9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shroyer (4,353,327) in view of Lin (4,942,685).

Shroyer discloses a display apparatus comprising: a frame member **12** having an exterior side, an interior side, an inner perimeter, and a center opening defined by the inner perimeter; a housing **10** mounted to the frame member and extending outward from the interior side of the frame member, the housing including: a rear wall **22**, the rear wall **22** having an edge extending around the perimeter of the rear wall; a side member **14**, **16**, **18**, **20** having opposing ends, the first end mounted to the edge of the rear wall **22** and the second end disposed adjacent the interior side of the frame member **12**; and a recessed area (Fig. 3) defined by the rear wall **22** and

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the side member **14**, **16**, **18**, **20**, wherein the recessed area has a depth sufficient for containing a three-dimensional object **68**; a transparent plate **24** located within the center opening of the frame member **12**, the transparent plate **24** spaced apart from the rear wall **22** of the housing **10**, wherein the interior side of the frame member further comprises a notch portion (col. 2, lines 56-60) for retaining the transparent plate **24**, the notch portion extending along the inner perimeter of the frame member **12**. However, Shroyer does not disclose a light source mounted within the recessed area. Lin teaches that it was known in the art to provide a light source in the recessed area of a shadow-box. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the display apparatus disclosed by Shroyer with a light source and a power source for the light source, as taught by Lin, in order to illuminate the display.

Regarding claim 3, see shelf **74**.

Regarding claim 5, strips **42** comprise a plurality of brackets situated as claimed.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shroyer (4,353,327) in view of Lin (4,942,685), as applied to claim 2, above, and further in view of Herrin et al. (3,503,147).

Shroyer discloses the invention substantially as claimed, as set forth above, including a three-dimensional object **52** attached to the rear wall **22** of the housing **10**. However, Shroyer does not disclose how the object is attached. Herrin teaches that it was known in the art to attach a display to the back wall of a shadow box via adhesive. It would have been obvious to one having ordinary skill in the art at the time the invention was made to attach the display element

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52 disclosed by Shroyer to the back wall of the display using adhesive, as taught by Herrin, in order to hold the element permanently in place.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shroyer (4,353,327) in view of Lin (4,942,685), as applied to claim 6, above, and further in view of Jenkins (5,426,573).

Shroyer, as modified, discloses the invention substantially as claimed, as set forth above. However, the light source is LED, rather than a fluorescent lamp. Jenkins teaches that a fluorescent lamp is a functionally equivalent structure known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the LED lamp disclosed by Shroyer, as modified, with a fluorescent lamp, as taught by Jenkins, as an obvious matter of choice in design, based on such factors as cost and availability of parts to the designer.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shroyer (4,353,327) in view of Lin (4,942,685), as applied to claim 6, above, and further in view of Hermann (5,555,654).

Shroyer, as modified, discloses the invention substantially as claimed, as set forth above. However, the light source is LED, rather than a flexible light strip covered by a heat resistant material. Hermann teaches that a flexible light strip 51 covered by a heat resistant material 52 to absorb the heat of the light source is a functionally equivalent structure known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the LED lamp disclosed by Shroyer, as modified, with a flexible light strip

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covered by a heat resistant material, as taught by Hermann, as an obvious matter of choice in design, based on such factors as cost and availability of parts to the designer.

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shroyer (4,353,327) in view of Lin (4,942,685), as applied to claim 1, above, and further in view of O'Brill (4,424,449).

Shroyer, as modified, discloses the invention substantially as claimed, as set forth above. However, the transparent plate is a sheet of glass. O'Brill teaches that acrylic is a functionally equivalent material known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the glass sheet disclosed by Shroyer with an acrylic sheet, as taught by O'Brill, as an obvious matter of choice in design, based on such factors as cost and availability of the materials to the designer.

11. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shroyer (4,353,327) in view of Lin (4,942,685), as applied to claim 1, above, and further in view of DeWitt (6,776,505).

Regarding claims 15 and 17, Shroyer, as modified, discloses the invention substantially as claimed, as set forth above. However, the power source is mounted outside of the housing. DeWitt teaches that it was known in the art to mount a power source inside the housing (see Fig. 6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to mount the power source disclosed by Shroyer, as modified, inside the housing, as taught by DeWitt, in order to protect the power source, and to keep it hidden from view.

Regarding claims 16 and 18, Shroyer, as modified, discloses the invention substantially as claimed, as set forth above. However, the power source is a battery. DeWitt teaches that it was

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known in the art to use an alternating current power supply for illuminating a display. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an alternating current power supply to illuminate the display disclosed by Shroyer, as modified, as taught by DeWitt, in order to avoid having to replace depleted batteries.

Response to Arguments

12. Applicant's arguments with respect to claims 1-9 and 11-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary C Hoge
Primary Examiner
Art Unit 3611

gch